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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,982	01/21/2000	Thomas G Stoll	99,308	6538

7590

10/29/2002

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EXAMINER

BLECK, CAROLYN M

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,982

Applicant(s)

STOLL ET AL.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendments filed 15 August 2002.

Claims 1-19 have been amended. Claim 20 is newly added.

Claim Objections

2. The objections of claims 1-4, 6-9, and 12-13 are hereby withdrawn due to the amendment filed on 15 August 2002.

3. The objections of claims 15-16 and 18 are hereby withdrawn due to the amendment filed on 15 August 2002.

Claim Rejections - 35 USC § 112

4. The rejections of claims 15-19 under 35 U.S.C. 112, second paragraph, are hereby withdrawn due to the amendment filed on 15 August 2002.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz (6,397,190) for the same reasons given in the previous Office Action (paper number 4), and incorporated herein.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz (6,397,190).

(A) Claim 20 differs from claim 2 by reciting a "second access code" rather than a "first access code." As per this feature, note the discussion given in the previous Office Action with respect to Goetz's disclosure of the first access code. It is respectfully submitted that it would have been obvious to one having ordinary skill in the art at the time of the invention to have utilized multiple passwords and/or PINs within the Goetz system with the motivation of improving the security of the system.

Affidavit

8. Applicant has submitted an affidavit to remove Goetz (6,397,190) as a reference applied under 35 U.S.C. § 103(a) in the previous Office Action. The affidavit filed on 15 August 2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Goetz reference for the following reasons:

(A) The affidavit includes correspondence to a patent agent, including enclosures dated October 1, 1998 (Annex A), which inform that diagrams and drawing of the invention

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had been completed, and the faxed correspondence from an engineer/ draftsman dated September 25, 1998 (Annex B), which inform that drawings of the invention had been completed, are dated after the effective filing date, July 22, 1998, of the Goetz reference, due to a filing of a provisional application (60/093,753) by Goetz. Therefore because Applicant's correspondences occurred after the effective filing date of the Goetz reference, they therefore fail to antedate the previously applied reference.

(B) The affidavit includes a copy of a printout from the corporations database of the Missouri Secretary of State, verifying an incorporation dated 9 May 1997 (Annex C) and a copy of an IRS Form 2553 dated 14 March 1998 (Annex D), thereby alleging diligence and reduction to practice of the instant invention prior to the filing date of the Goetz reference. It is respectfully submitted there is no clear nexus between the materials and the claimed subject matter. In particular, Applicant has not pointed out specific portions of the submitted printouts directly tied to the specific elements or features that are being claimed. For example, Applicant has not pointed out the portions of the submitted printouts tied to the step of "uploading prescription data..." as per the language of claims 1, 7, and 14 and the steps of "entering a first access code" and "entering a second access code" as per the language of claims 2, 7, and 20. Furthermore, although the printouts are acknowledged and entered into the record by the Examiner, it is noted there is nothing related to the language recited in the instant claims within the submitted printouts, and therefore the printouts appear to be irrelevant to the issues at hand.

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(C) The affidavit and correspondence from Kemnitzer Design dated 27 December 1997 fail to establish a clear nexus between the correspondence and the claimed subject matter. The evidence is not commensurate in scope with the scope of the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (1971). In particular, there is nothing that directly ties the statements given on pg. 21 par. 4 (see Part d) and pg. 22 par. 1 of the affidavit, nor the correspondence attached in Annex E, specifically par. 1 "Project Overview" of Annex E, with the language specifically recited in the claims. Applicant's reliance on Annex E to antedate the previously applied reference is non-persuasive as the nexus between the overview and the features explicitly recited in the instant claims is not clearly established. Also, the Applicant has not pointed out the specific portions of the submitted materials directly tied to each and every element, feature, or step that is being claimed.

Response to Arguments

9. As Applicant fails to provide any further arguments other than the reliance on Affidavit evidence that is ineffective to remove the Goetz reference for the reasons given above, the rejections are hereby maintained.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a medication

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management system which includes three components to assist a patient with control, monitoring, and managing the administration of prescribed medications (6,421,650), an information system and method for remotely gathering information and storing information for access (6,408,330), a pulmonary drug delivery device (6,435,175), and an integrated system and method for vending prescription medications using a network of remotely distributed, automated dispensing units (6,438,451).

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The examiner can normally be reached on Monday-Friday, 8:30am – 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

13. **Any response to this final action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:


(703) 305-7687	[Official communications; including After Final communications labeled "Box AF"]
(703) 746-8374	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB

CB

October 21, 2002


JOSEPH THOMAS
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